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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,247	09/18/2000	Wilhelm Elsner	2384/001440	4085

28289 7590 01/31/2006

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PITTSBURGH, PA 15219

EXAMINER
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MCCORMICK EWOLDT, SUSAN BETH

ART UNIT	PAPER NUMBER
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1655

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/664,247	<b>Applicant(s)</b> ELSNER, WILHELM	
	<b>Examiner</b> S. B. McCormick-Ewoldt	<b>Art Unit</b> 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

The finality of the previous Office action dated March 13, 2003 is hereby withdrawn and prosecution is hereby re-opened.

#### **Status of Application**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1655.

#### **Claims Pending**

Claim 1 will be examined on the merits.

#### **Objection to the Declaration**

The declaration does not state the plant was found in a cultivated area.

#### **Drawings**

The drawings have been approved by an official draftsman.

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected over Plant Breeder's Right application number, 970950, in light of the Halpin reference and Applicant's admission that the claimed plant was sold as early as July 1998 in Germany (page 2 of replies dated October 5, 2001 and dated July 15, 2005). The claimed geranium plant 'Pendec' was described in the following printed publication more than one year

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prior to the effective filing date of this instant plant application filed on September 18, 2000. The claimed geranium variety 'Pendec' is described in application number, 970950, filed in the European Community on September 3, 1997. The application number, 970950, was published on December 15, 1997, more than one year prior to the filing date of the instant application. The published application is a "printed publication" under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates.

The publication cited above disclose the claimed variety. Applicant stated on July 15, 2005 that he is not aware of any public information regarding sales or public distribution of the instant cultivar anywhere in the world and any information regarding the reproducibility of the instant cultivar. However, there is evidence that show that the instant cultivar was accessible to the public and described in the printed publication, more than one year prior to the effective filing date of this instant plant application. For example, as discussed above the instant cultivar was described in the printed PBR application and Applicant's admission indicates that the claimed cultivar was accessible to the public more than one year prior to the effective filing date of instant plant application. The foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. One of ordinary skill in the art would have known where to obtain the claimed plant because UPOV-ROM discloses the Applicant as Elsner Pac Jungpflanzen. For example, the Internet discloses 'Elsner' <http://www.pac-elsner.com> and one could have easily contacted one of the links or gone directly to the "Contact" link and requested information by phone, fax, or e-mail. With that contact information, one of ordinary skill in the art could have checked the availability of the claimed plant and where to purchase the plant. With regard to the reproducibility of the claimed cultivar, a person skilled in the art would have had the knowledge of reproducing the instant cultivar, given the notoriety of various methods of asexual propagation, including geraniums, as shown by "Horticulture- Gardner's Desk Reference, 1996, pp. 82-85.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re Le Grice*, 301 F.2d 929,133 USPQ 365 (CCPA 1962). If one skilled in the art could obtain or reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24

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USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether 'Siokra' seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the cultivar Siokra disclosed in the cited publications."). Moreover, the Court in *In re Elsner*, 72 USPQ2d 1038 (CA FC 2004) states that a printed publication coupled with a foreign sale of the plant would constitute a bar under §102(b) on page 1040.

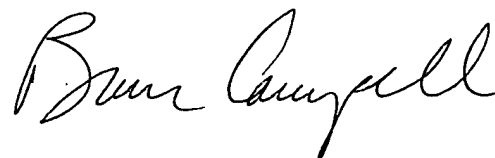
Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiners' supervisor, Terry McKelvey, can be reached at (571) 272-0775. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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